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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/019,114

Applicant(s)
Clapp et al.

Examiner
Jacob Hart

Group Art Unit
2782



☒ Responsive to communication(s) filed on 2-5-98, 5-8-98, 12-21-98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 54-80 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 54-80 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This case is a continuation of serial no. 08/302,108 filed on 09/07/94, which has been patented and issued (patent no. 5,802,281, patented on 09/01/98).
2. New claims 54-80 are presented for examination.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 54-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over selected claims of U.S. Patent No. 5,802,281.

Although the conflicting claims are not identical, they are not patentably distinct from each other for reasons set forth below:

5. As to claim 54, claim 1 in patent no. 5,802,281 discloses a system for communicating with a communication channel and a separate host processor, wherein the host processor is housed in a computer system housing and coupled to a display, wherein the system further

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comprises a peripheral housing separate from the computer system housing; and an audio/visual communication system integral to the peripheral housing, the audio/visual communication system comprising: a source input interface, a local transmission interface, a local receive interface and an output interface. Claim 1 in patent no. 5,802,281 further discloses that the separate host processor controls the presentation of a remote signal on the display device.

Claim 1 in patent no. 5,802,281, however, does not recite a control unit, as presented in new claim 54, that controls the presentation of remote signals on the display device.

Given claim 1 in patent no. 5,802,281, it would be obvious to one having ordinary skill in the art that the host processor and the control unit may be construed as being the same thing because they both perform the function of controlling the display of remote signals on the display device, and they both may reside outside of the audio/video peripheral's housing.

6. Claim 55 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of patent no. 5,802,281 in view of Shibata et al. patent no. 5,477,546.

Claim 1 of patent no. 5,802,281 teaches a system for communicating with a communication channel and a separate host processor, the separate host processor being housed in a computer system housing, the system comprising a audio/video peripheral housing separate from the computer system housing.

Claim 1 does not teach that the control unit (host processor) is disposed in the audio/video peripheral housing.

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Shibata et al. teaches of teleconference terminal equipment which has a control unit (interterminal signal control unit) disposed its housing for controlling the display of remote signals on a display (8, Fig. 1). Given the disclosure of Shibata et al., it would be obvious to one having ordinary skill in the art to put the host processor inside of the audio/video peripheral housing instead of its own separate computer system housing to control the display of remote signals because this would increase the portability of the device by requiring less equipment to be moved when transporting the device to different sites.

7. As to claim 56, claim 1 of patent no. 5,802,281 teaches a system for communicating with a communication channel and a separate host processor. It has been established that the separate host processor and the control unit, as claimed in new claim 54, could be construed as the same device (see no. 5 above).

Claim 1 of patent no. 5,802,281 is silent with respect to the control unit (separate host processor) being controlled by a user interface device.

It would be obvious to one having ordinary skill in the art that a user interface device could be coupled to the separate host processor, which also interfaces with a user [col. 7, lines 31-33], because this would allow for a multi-user environment in which the user interface device would be able to utilize the resources of the separate host processor (e.g. a client-server network).

8. As to claim 57, claim 1 of patent no. 5,802,281 teaches a system for communicating with a communication channel and a separate host processor. It has been established that the separate host processor and the control unit, as claimed in new claim 54, could be construed as the same

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device (see no. 5 above). It has further been established that a user interface device could be coupled to the separate host processor (see no. 7 above).

Claim 1 of patent no. 5,802,281 is silent as to the user interface device being separate from the audio/video peripheral housing.

It would be obvious to one having ordinary skill in the art to separate the user interface device, as set forth in no. 7 above, from the audio/video peripheral housing because the multiple users/operators would be able to control the separate host processor (control unit) from many different locations.

9. As to claim 59, claim 28 of patent no. 5,802,281 discloses that a host processor comprises a means for displaying a video image associated with the remote decoded video signal within a video window displayed on the display; and a means for modifying the size of the video window displayed on the display device. Having established the contention that the control unit as claimed in the new claim 54 could be construed as the same thing, it is therefore determined that new claim 59 is an obvious variation of the patented (no. 5,802,281) claims 28 and 14 (see no. 5 above for control unit/host processor explanation).

10. As to claim 60, claim 28 of patent no. 5,802,281 teaches that the host processor displays a video image in a video window and that the size of the window may be modified.

Claim 28 of patent no. 5,802,281 is however silent with respect to there being software that cooperates with a control unit to display the video images in a display window.

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Again, the contention is made that the control unit and the host processor may be construed as the same thing (see no. 5 above). Thus, it would be obvious to one having ordinary skill in the art that , inherently, a host processor must have some type of software operating thereon in order to function properly. Therefore, since the host processor controls the display of video images in a window on the display, it would be obvious that inherently the software cooperates with the host processor to display a video image in a window on the display. For example, in claim 9 of patent no. 5,802,281, clearly software is being used in cooperation with the host processor to display images on the display unit.

11. As to claim 61, claim 23 of patent no. 5,802,281 discloses that the separate host processor has a means for simultaneously displaying video images associated with the remote and source video signals. Once again, the control unit and the host processor could be construed as being the same thing (see no. 5 above). Therefore, in light of the congruency between the control unit and the host processor, claim 61 is an obvious variation of claims 23, 21 and 14 of patent no. 5,802,281.

12. As to claim 62, claim 23 of patent no. 5,802,281 discloses that the separate host processor has a means for simultaneously displaying video images associated with the remote and source video signals.

However, claim 23 of patent no. 5,802,281 does not teach that software is used in cooperation with a control unit to simultaneously display video images on the display.

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The limitations of new claim 62 are obvious variations of claims 23, 21 and 14 of patent no. 5,802,281 for reasons set forth in no. 11 of this Office Action.

13. As to claims 63 and 64, claim 1 of patent no. 5,802,281 teaches that a host processor coordinates communication of the remote video signal between the local receive unit and the output interface. Claim 1 of patent no. 5,802,281 also teaches that the host processor produces a coordination instruction; and the output interface receives the coordination instruction and communicates the coordination instruction between the output interface and the local receive unit. Thus, having established the congruency between the host processor and the control unit in new claims 63 and 64 (no. 5 of this Office Action), these limitations are obvious variations of claim 1 in patent no. 5,802,281.

14. As to claims 65, 66, and 68, claim 10 of patent no. 5,802,281 teaches that a host processor:

produces a request coordination instruction; and the local receive unit transmits at least a portion of the remote video signal to the output interface in response to the request coordination instruction;

software that cooperates with the host processor to coordinate the communication of the remote video signal between the local receive unit and the output interface;

the software cooperates with the host processor to produce a request coordination instruction; and the local receive unit transmits at least a portion of the remote video signal to the output interface in response to the request coordination instruction.

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Since it has been established that the control unit and the host processor may be construed as being the same (no. 5 of this Office Action), these limitations are obvious variations of claim 10 in patent no. 5,802,281.

15. As to claims 67, 69-73 and 77, these new claims cite limitations that are all obvious variants of corresponding claims in patent no. 5,802,281 in light of the congruency between the control unit and the host processor argument that has been established in no. 5 of this Office Action. The new claims and their respective claims in patent no. 5,802,281 which correspond to the newly claimed limitations are listed as follows (new claims are listed first): 67 and 9, 69 and 12, 70 and 12, 71 and 25, 72 and 26, 73 and 27, and 77 and 1. As such, these new claims are rejected accordingly.

16. As to claims 74-76, claim 1 of patent no. 5,802,281 teaches a display which is capable of displaying video images.

Claim 1 of patent no. 5,802,281 is silent with respect to the display being specifically a television, or a video monitor. Further, claim 1 of patent no. 5,802,281 is silent as to a video monitor being coupled to a host computer.

As mentioned, the display in claim 1 of patent no. 5,802,281 is capable of displaying video images. It would be obvious to one having ordinary skill in the art that a television or a video monitor could be used with the claimed invention because these are display media which are well-known to have the capability of displaying video images. Further, these devices could be adapted to be used with a computer for they are capable of receiving digital signals (e.g. coaxial

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cable connection or rca video game connectors). In addition, it is well known that a television is capable of receiving analog signals (via the antenna). It would thus be the designer's choice to utilize such video display devices.

It would be obvious to one having ordinary skill in the art that the video monitor could be coupled to a host computer because it has been established that the control unit as cited in claim 54 could be construed as a host computer (no. 5 of this Office Action). Thus, it would be obvious to choose the video monitor as the display device as set forth above.

17. Claims 78-80 are obvious variants of claim 1 in patent no. 5,802,281 for reasons set forth in no. ¹⁷₁₆ (above) of this Office Action.

Claim Rejections - 35 USC § 103

18. The following is a quote of the appropriate paragraphs of 35 U.S.C. 103 that form the basis for the rejections which follow in this Office Action:

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 54-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al., patent no. 5,477,546.

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21. As per claim 54, Shibata et al. discloses a system for communicating information over a communication channel. Shibata et al. does not explicitly disclose a peripheral housing, however, a teleconference terminal equipment is disclosed, which implies a separate unit that has its own housing.

Shibata et al. further discloses a source receive unit for receiving source audio and video signals (multimedia multiplexing and demultiplexing and interterminal signal unit, 8 Fig 1, Col 5 Lines 31-38) , a local transmission unit for transmitting the source audio and video signals over the communication channel (network interface and communication network control unit, 9 Fig 1, Col 5 Lines 24-26), and a local receive unit for receiving remote audio and video signals from the communication channel (network interface and communication network control unit, 9 Fig 1, Col 5 Lines 24-26).

Shibata et al. discloses an output interface (RS-232 connector, 105 Fig 1) for connecting to an external computer (Col 7 Lines 13-15) and sending computer data/data to be multiplexed/demultiplexed to the external computer (Col 15 Lines 50-53). It would be obvious to one having ordinary skill in the art that computer data may be interpreted to mean any type of data that is understood by the external computer (i.e. streams of 1's and 0's which could represent whether a pixel in a display array is on or off/ lit or not lit). Therefore, since it is well known that video data can be represented in a form that is understandable by a computer, video data could be interpreted as a form of computer data. Furthermore, Shibata et al. discloses that the multimedia multiplexing/demultiplexing and interterminal signal control unit performs various controls

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between the pertinent terminal equipment and the opposite terminal equipment such as demultiplexing received data into appropriate individual data types and routing this data to the appropriate terminal equipment (Col 15 Lines 40-54). One having ordinary skill in the art would be motivated to adapt the multimedia multiplexing/demultiplexing and interterminal signal control unit to route video data to the RS-232 connector, and thus to the external computer because these video images may then be stored on a disk and manipulated if so desired by the user.

Shibata et al. does not explicitly disclose that a remote video signal is communicated between the local receive unit (network interface and communication network control unit) and a display device (which inherently would be coupled to a computer which is connected to RS-232 connector), however, given the data type/routing arguments stated above, one having ordinary skill in the art would recognize that video signals could be sent between these two components.

Shibata et al. further discloses a control unit (the multimedia multiplexing/demultiplexing and interterminal signal control unit; 8 Fig 1) that controls the presentation of the remote video signal on the display device (inherently coupled to the external computer connected to the RS-232 connector); wherein the source receive unit, local transmission unit, local receive unit, and output interface are respectively disposed in the housing (Fig 1), and the display device is physically separate from the housing (inherently the display device coupled to the external computer connected to RS-232 connector would be separate from the teleconference terminal equipment).

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22. As to claim 55, Shibata et al. discloses that the control unit is disposed in the housing of the unit (8 Fig 1).

23. As to claims 56 and 57, Shibata et al. discloses that the control unit is controlled by a user interface device that is separate from the housing (conference console; 2920 Fig 21).

24. As claim 58, Shibata et al. discloses that the user interface device (conference console; Fig 25a) has a CPU (3007 Fig 25a) and a numeric keyboard (2903 Fig 22). However, Shibata et al. does not teach that the conference console has a telephone or a mouse. Shibata et al. teaches that the conference console has microphone inputs (2910 Fig 22). It is well known in the art that a telephone has a type of microphone in its handset. One having ordinary skill in the art would recognize that a telephone could be used to input microphone signals to the conference console.

Shibata et al. does not teach that a mouse is capable of being connected to the conference console. Nevertheless, Shibata et al. does teach that a mouse may be connected to teleconference terminal equipment (104 Fig 1). It would be the designer's choice to connect the mouse either directly to the teleconference terminal equipment or to connect the mouse to the conference console.

25. As to claims 59 and 61, Shibata et al. discloses that the control unit simultaneously displays a video image associated with the remote and source video signals within a video window (frame) displayed on a display device (401,402 Fig 4a-f). Shibata et al. does not explicitly state that the displayed window is on a display which is coupled to an external computer at the RS-232 connector. However, having established that with modification, video

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output could be sent to the RS-232 connector, this video data could be displayed on the external computer's display in this manner.

In addition, Shibata et al. does not explicitly disclose that the size of the window in which the video images are displayed may be modified. However, one having ordinary skill in the art would recognize that sizeable windows in which data may be displayed on a display device are well known in the art (e.g. Microsoft Windows). It would be obvious to include this feature because the user would then be able to configure the display to his/her liking.

26. As to claims 60, 62, 66, and 70, Shibata et al. discloses that the control unit (8 Fig 1) includes a CPU (26 Fig 1). Inherently a CPU must have some type of software running thereon to function properly. Thus, inherently the CPU uses this software to perform its functions as implemented in the Shibata et al. system..

27. As to claim 63, Shibata et al. discloses that remote video data that is received in a communication frame at the network interface and communication network control unit (9 Fig 1) and is subsequently passed to the multimedia multiplexing/demultiplexing and interterminal control unit (8 Fig 1). Next, Shibata et al. teaches that the remote video data is then output through the video switch (VSW; 4 Fig 1). Thus, the multimedia multiplexing/demultiplexing and interterminal control unit is shown to be coordinating the communication of received remote video signals between the receive unit (network interface and communication network control unit) and an output interface (video switch) (Col 6 Lines 26-33).

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Shibata et al. is silent with respect to the received remote video signal being communicated via the multimedia multiplexing/demultiplexing and interterminal control unit to an external computer which is connectable at RS-232 connector. Nevertheless, for reasons stated above in no. 22 of this Office Action, the multimedia multiplexing/demultiplexing and interterminal control unit could be reasonably modified to route the video data to the RS-232 connector.

28. As per claims 64, 65, 67, 68, inherently since the multimedia multiplexing/demultiplexing and interterminal control unit is coordinating the receipt and transmission of remote and source video signals between the output interface (which has been established could be the RS-232 connector) and the local receive unit (network interface and communication network control unit), some type of coordinating instructions must be issued by the multiplexing/demultiplexing and interterminal control unit to perform the desired functions.

29. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. as applied to claim 54 above, and further in view of Shaw et al., patent no. 5,611,038.

Shibata et al. substantially discloses the applicant's claimed invention as claimed in claim 54. However, Shibata et al is silent with respect to the control unit being able to adjust the bandwidth of the communication channel.

Shaw et al. discloses an audio/video transceiver with a host processor (control unit; 314 Fig 16a) that is able to adjust the bandwidth of a communication interface (Col 8 Lines 16-33).

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Given the disclosures of Shibata et al. and Shaw et al., one having ordinary skill in the art would readily recognize that it would be desirable to include the bandwidth adjustment feature in the Shibata system because the system would then have the versatility to interface with a wide range of communication networks (Col 8 Lines 16-20).

30. As to claims 71-73, Shibata et al. discloses that when a reception has arrived at the teleconference module, a message indicating the incoming call is displayed on a display device (Col 22 Lines 20-25 and Fig 32f). Thus, having established that the multimedia multiplexing/demultiplexing and interterminal control unit is coordinating the receipt and transmission of video signals between the remote and local sites, inherently this control unit is utilized to detect incoming communications, display receipt messages, and respond to a user's commands to coordinate the receipt and transmission of video signals.

31. As to claims 74-76, 78, 79 and 80, Official Notice is taken that televisions and video monitors are well known types of display devices that are capable of receiving and displaying video images in both analog and digital form. As such, it would be the designer's choice to utilize such devices. For example, Falza, patent no. 4,460,918 discloses a television receiver that is capable of receiving both standard video signals and video signals sent from a computer.

32. As to claim 77, Shibata et al. is silent with respect to the control unit being a separate host processor. Nevertheless, having established that a separate host computer may be connected at RS-232 connector, one having ordinary skill in the art would readily recognize that disposing the


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control unit, with its software and functions, inside a separate host computer would allow for easier future upgrading of the functionality of the control unit.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Hart whose telephone number is (703) 305-9669. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee, can be reached on Monday through Friday from 8:30 a.m. to 4 p.m at (703) 305-9717. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.



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